The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DIETER LUTZ and GOTTFRIED ZIMMERMANN

Appeal No. 2004-2154
Application No. 10/067,049

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7-10. Claims 1, 4-6 and 12-14, the only other claims pending in this application, stand allowed (see Paper No. 13).

We REVERSE.

BACKGROUND

The appellants' invention relates to a vibration damper for a vehicle of the type having a pressure tube filled with a damping medium, a piston and piston rod axially moveable in the pressure tube and a damping device which produces a damping force as a function of the movement of the piston and rod and the flow of damping medium through the damping device, the damper being provided with a damping force-limiting device which becomes active when the damping force exceeds a certain threshold, which is defined as a function of the vehicle (specification, pages 2 and 4). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Freitag	3,995,842	Dec. 7, 1976
Pradel et al. (Pradel) (German patent document)	DE 19823878	Dec. 23, 1999[1]

The following rejections are before us for review.

Claims 7-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pradel.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pradel in view of Freitag.

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[1] We derive our understanding of this reference from the English language translation appended to appellants' brief (Paper No. 14) as Appendix B.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 14 and 16) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the rejection of claim 7 as being anticipated by Pradel. The issue in dispute is whether Pradel discloses a damping device comprising "a vacuum throttle which reduces flow from the equalizing space to the working space away from the piston rod as said piston rod moves outward, thereby developing a negative pressure in the working space away from the piston rod" as called for in claim 7. According to the examiner (answer, pages 3 and 4), the vacuum throttle "can be readable as bottom valve 4a in fig. 7, which reduces flow from the equalizing space to the working space away from piston rod as said piston rod moves outward, thereby developing a negative pressure in the working space away from piston rod."

We, like appellants, find no support for the examiner's position that Pradel's bottom valve 4a reduces flow from the equalizing space to the working space as called for in claim 7. While movement of the piston rod outward creates a negative pressure in the lower working space, thereby opening the bottom valve and drawing damping medium from the equalizing space to the working space, Pradel provides no disclosure that the bottom valve comprises structure which reduces flow as the piston rod moves outward.[2] Accordingly, the subject matter of appellants' claim 7 cannot be considered to be anticipated[3] by Pradel.

With regard to the rejection of claims 8 and 9 as being anticipated by Pradel, we likewise find no support in Pradel for the examiner's position that the predetermined breaking point recited in claim 8 "can be readable as the valve disc on the bottom valve 4a, which breaks to open a bypass connecting said at least one working space to said equalizing space when damping medium exceeds a predetermined pressure in said working space" (answer, page 4). Pradel provides no indication that any portion of the bottom seal 4a, including the flexible disc thereof which presumably flexes under pressure to allow fluid flow through the valve, is designed to break when the damping

[2] The Alliquant patent (U.S. Pat. No. 3,958,673) referred to by the examiner on page 6 of the answer has been given no consideration in deciding this appeal since it was not positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970).

[3] To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

medium exceeds a **predetermined**[4] pressure in the working space, as required by claim 8. To the extent that the examiner's position as expressed in the last two paragraphs on page 7 of the answer is that the flexing of the disc to move it from its seat constitutes "breaking" as used in appellants' claim 8, this is not a fair and reasonable reading of this term.

For the foregoing reasons, we shall not sustain the rejection of claims 7 and 8 or claim 9 which depends from claim 8.

In rejecting claim 10 as being unpatentable over Pradel in view of Freitag, the examiner recognizes that Pradel lacks the pressure tube comprising the predetermined breaking point but relies on the teachings of Freitag for a suggestion to modify Pradel's pressure tube to comprise such a feature. We, however, find no such suggestion in Freitag, which is directed to pneumatic springs of the piston-and-cylinder type and particularly to a pneumatic spring equipped with a safety release, in the form of a frangible reduced wall portion, for its compressed gas charge, such as those used under engine compartment hoods and trunk lids of passenger cars (column 1, lines 3-

[4] The present situation is analogous to that in In re Weiss, 989 F.2d 1202 (Table), 26 USPQ2d 1885, 1887 (Fed. Cir. 1993), wherein the position of the USPTO that a means for breaking away a cleat at a preselected level of force requires only that a cleat break away when some level of force is applied, regardless of any intention to break away, was found to be in error. Akin to the situation in Weiss, appellants' specification discloses a specific structural element (decreased wall thickness 41 in the pressure tube 7 or a thin floor 51 in the central fastening means 49 in the bottom valve 27) which responds at a specific predetermined pressure by causing the tube or fastening means to break. Appellants' specification further indicates that the predetermined pressure is defined as a function of the vehicle. We thus conclude that the "predetermined breaking point" in appellants' claim 8 requires specific structure designed to break when the pressure in the working space exceeds a predetermined pressure.

9). Inasmuch as Freitag expressly contrasts the pneumatic springs under the engine compartment hoods or trunk lids, which are much more likely to be damaged in collisions, with similar springs used in wheel suspensions, Freitag would not have suggested to one of ordinary skill in the art the need for the inventive safety release in the cylinder of a vehicle suspension vibration damper of the type disclosed by Pradel. We thus agree with appellants that the modification proposed by the examiner would not have been rendered obvious by the combined teachings of Pradel and Freitag. It follows that we shall not sustain the rejection of claim 10.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7-9 under 35 U.S.C. § 102 and claim 10 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. MCQUADE Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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